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48. The method of claim 46, wherein the liberation of the inorganic phosphate from the phytate in said foodstuff occurs in part prior to and in part after the ingestion of said foodstuff by a recipient organism.

REMARKS

Claims 1-40 were pending before this Response. By the present amendment, new claims 41-48 have been added and claim 18 has been amended as shown in Exhibit A attached to define Applicants invention with greater particularity. The new claim language adds no new matter, being fully supported by the Specification and original claims. Applicants submit that the claim amendment does not narrow the claims in any way within the meaning of Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd., a/k/a SMC Corporation and SMC Pneumatics, Inc. 234 F.3d 558, 51 U.S.P.Q. 2d 1959 (Fed. Cir. 2000). Accordingly, claims 1-48 are currently pending.

The Restriction Requirement

The restriction of claims 1-40 under 35 U.S.C. § 121 is respectfully traversed. It is respectfully submitted that the claims have been inappropriately divided into ten search categories. Applicants respectfully submit that the Group I claims (claims 1-5, drawn to a method for improving the nutritional value of phytate-containing foodstuff); the Group II claims (claims 6-16, drawn to vectors and host cells comprising a nucleic acid molecule encoding a phytase according to SEQ ID NO:2); the Group III claims (Claims 17 and 19, drawn to a plant and plant parts containing an expression system which comprises a nucleic acid molecule encoding a phytase according to SEQ ID NO:2 as well as a composition comprising said plant and plant parts); Group IV claim (claim 18, drawn to a method to produce animal feed containing a microbial phytase and new claims 41-48); and Group V claim (Claim 20, drawn to a method to treat a human or animal) could readily be rejoined for prosecution together in the same application.

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All of the claims in Groups I-V have common requirements relating to molecules and methods for production of particular recombinant phytases and their methods of use. In particular, Applicants respectfully request rejoinder of Groups II, III, IV and V. Group II (claims 6-16) are drawn to vectors and hosts used in claims 17 and 19 (Group III) and 18 and 41-48 (Group IV). In addition, Group V (claim 20) provides treatment to humans and other animals with phytases that could be produced by the method of claim 18. Thus, a search of prior art for claims of any of Groups II-V would necessarily entail search of art that would be searched for the other three groups.

Alternatively, Applicants respectfully request rejoinder of Groups I, II and IV. The vectors and host cells of claims 6-16 (Group II) would be used in the methods of claims 1-5 for improving the nutritional value of foodstuffs (Group I) and in the methods of claim 18 and new claims 41-48 for producing animal feed containing a microbial phytase (Group IV). In addition, the claims of Groups I, II and IV are classified together in search class 435, with Groups I and IV being additionally classified together in subclass 196. Thus, it is particularly true that a search of prior art for claims of any of Groups I, II and IV would necessarily entail search of art that would be searched for the other two groups.

Therefore, it is respectfully submitted that there would be no serious burden on the Examiner to consider all the pending claims together in a single application. Alternatively, at least the claims of Groups II-V or Groups I, II and IV could readily be rejoined and considered together in a single application. Accordingly, reconsideration of the requirement of restriction is respectfully requested.

In order to be fully responsive, however, Applicants provisionally elect the Group IV claims (i.e., claim 18 and new claims 41-48) with traverse. Non-elected claims from Groups I-III and Groups V-X (i.e., claims 1-17 and 19-40) are retained in this application pending final disposition of the elected claims.

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In view of the above remarks, reconsideration and prompt action on all claims is respectfully requested. Should any questions remain in view of this communication, the Examiner is invited to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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EXHIBIT A

A marked up version of the amendments

In the claims:

Please amend claim 18 as follows:

18. (Amended) A method to produce an animal feed containing a microbial phytase comprising:

a) preparing a plant cell, plant part or plant that contains a recombinant expression system comprising a phytase-encoding nucleic acid sequence having a nucleotide sequence selected from

i) SEQ ID NO:1, and

ii) SEQ ID NO:1, wherein T can also be U;

[a]b) culturing the plant cell, plant part or plant [of claim 17] under conditions wherein said nucleotide sequence is expressed; and

[b]c) converting said plant cells, plant parts or plants into a composition suitable for animal feed, wherein the animal feed contains phytate and the phytase.

Please add the following new claims 41-48:

-- 41. The method of claim 18, wherein the recombinant expression system comprises a vector containing the nucleic acid sequence encoding said phytase.

42. The method of claim 18, wherein said nucleotide sequence is preceded by a polynucleotide sequence encoding a signal peptide operably linked to said nucleotide sequence.

43. The method of claim 41, wherein the nucleic acid sequence is operably linked to a transcription control sequence operable in said plant cells, plant parts or plants.

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44. The method of claim 43, wherein the control sequence comprises a tissue-specific promoter that is specific for the plant cells, plant parts or plants.

45. The method of claim 43, wherein the control sequence comprises a constitutive promoter.

46. The method of claim 18, wherein the phytase catalyzes liberation of inorganic phosphate from the phytate in the animal feed.

47. The method of claim 46, wherein the liberation occurs after the ingestion of said foodstuff by a recipient organism.

48. The method of claim 46, wherein the liberation of the inorganic phosphate from the phytate in said foodstuff occurs in part prior to and in part after the ingestion of said foodstuff by a recipient organism. --